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WILEY REIN LLP FAX CTR Fax:202-716-7049

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Application No. 10/608,257
Office action dated November 30, 2006
Response dated March 30, 2007

REMARKS

After entry of this amendment, claims 1 and 3-18 will be pending. Claims 3, 4, 10, and 13 stand withdrawn from consideration. Applicants thank the Examiner for indicating the allowability of claims 1, 5-9, 11, 12, and 14-18.

Claim 19 was rejected in the Office action. Without conceding the propriety of the rejection, and in order to advance prosecution, claim 19 is cancelled herein without prejudice or disclaimer. Applicants expressly reserve the right to pursue at least claim 19 in one or more continuation applications.

Applicants submit that the cancellation of claim 19 places the application in condition for allowance. Entry of this amendment is therefore respectfully requested.

Applicants have thoroughly reviewed the Office action, including the Examiner's remarks and the references cited therein. Applicants submit that the following remarks are fully responsive to the Office action, and that all pending claims are patentable over the cited references.

Rejection Under 35 U.S.C. § 102(b)

The Examiner rejects claim 19 under 35 U.S.C. § 102(b) as anticipated by United States patent no. 6,120,500 to Bednarek et al. ("Bednarek"). Though Applicants respectfully disagree with the Examiner, the rejection is moot in view of the cancellation of claim 19 herein in favor of one or more continuation applications.

Withdrawn Claims

Claims 3, 4, 10, and 13 were withdrawn in response to a restriction requirement. Claims 3 and 4 depend from, and are allowable for at least the same reasons as, claim 1. Claims 10 and 13 depend from, and are allowable for at least the same reasons as, claim 8. In light of the allowance of generic claims 1 and 8, Applicants respectfully request that the Examiner consider and indicate the allowability of the withdrawn claims. If the Examiner believes that an amendment is necessary to consider and allow the withdrawn claims, the Examiner is requested to contact the undersigned.

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PAGE 05 * RCVD AT 3/30/2007 3:34:25 PM [Eastern Daylight Time] * SVR:USPTO-EFAXF-311 * DNIS:2738300 * CSID:202 716 7049 * DURATION (mm:ss):02:48

PAGE 11/31 * RCVD AT 8/8/2007 6:17:49 PM [Eastern Daylight Time] * SVR:USPTO-EFAXF-112 * DNIS:2738300 * CSID: * DURATION (mm:ss):08:46

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Mar 30 2007 15:36 P.09

Application No. 10/608,257
Office action dated November 30, 2006
Response dated March 30, 2007

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CONCLUSION

In view of the foregoing remarks, Applicants respectfully submit that the application is in condition for allowance, and request that all rejections be withdrawn, that all pending claims be allowed, and that the application be passed to issue. If, for any reason, the Examiner finds the application to be in other than condition for allowance, the Examiner is invited to contact the undersigned in an effort to resolve any matter still outstanding before issuing another action.

Applicants have provided for a one-month extension of time herewith. Should a further extension of time be deemed necessary for this paper to be considered timely, Applicants hereby petition therefor under 37 C.F.R. § 1.136.

Authorization is hereby granted to charge any fees due with the filing of this document, including any fees for any further extensions of time deemed necessary, to Deposit Account No. 50-1129 with reference to Attorney Docket No. 08-044301US/82410-0014.

Respectfully submitted,

WILEY REIN LLP

Date: March 30, 2007

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,257	06/27/2003	Guy P. Vannoy	08-044301US	8338
32486 7390 06/08/2007 HEIMBECHER & ASSOC., LLC P O BOX 33 HAMEL, MN 55340-0033				
EXAMINER				
PEFFLEY, MICHAEL F				
ART UNIT		PAPER NUMBER		
3729				
MAIL DATE		DELIVERY MODE		
06/08/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

Office Action Summary

Application No.

10/808,257

Applicant(s)

VANNEY ET AL.

Examiner

Michael Paffley

Art Unit

3739

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any asserted patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2007.
 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-18 is/are pending in the application.
 4a) Of the above claim(s) 3, 4, 10 and 13 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1 and 5-9, 11, 12 and 14-18 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 6-27-03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
 3) ☐ Information Disclosure Statement(s) (PTO/853/08)
 Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-613)
 Paper No(s)/Mail Date _____
 5) ☐ Notice of Informal Patent Application
 a) _____
 b) Other _____

U.S. Patent and Trademark Office
 PTO/326 (Rev. 08-06)

Office Action Summary

Part of Paper No./Mail Date 20070523

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Finality Withdrawn

The examiner of record has found art deemed to meet the limitations of certain claims. Therefore, the previous Final Office action of November 30, 2006 is hereby vacated. The following action is non-final and includes a new grounds of rejection. It is noted that claims 3, 4, 10 and 13 remain withdrawn from consideration.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21 (2) of such treaty in the English language.

Claims 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Swartz et al (6,080,151).

Swartz et al disclose a catheter apparatus that includes a shaft (21) with an active portion at the distal end of the shaft. Swartz et al provide a plurality of lumens for carrying fluids and wires, and the cross-sectional views of the Figures show that the distal portion is asymmetric. The instant application claims do not point out what specific asymmetry is provided on the catheter device. A cross section that is not symmetrical, as is the case with the Swartz et al device, is deemed to meet the limitations of claim 8.

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Claims 1, 5, 6, 8, 9, 11, 12 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Underwood et al (6,820,155).

Underwood et al disclose a device that comprises a catheter shaft (312 – Figure 17) having proximal and distal portions. The distal portion is adapted to be inserted into a body cavity to ablate tissue and has a flattened outer peripheral wall (350,352) including electrodes that may be placed against tissue for ablation. Figure 17 shows the distal portion to be "D-shaped". With particular regard to claim 8, Underwood et al also disclose a lumen (360) for the passage of fluid.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Underwood et al ('155).

Underwood et al has been addressed above. While Underwood et al provide the same "D-shaped" distal end for the catheter device, there is no specific mention of the aspect ratio for the distal end of the "D-shaped" catheter. This aspect ratio is deemed to be an obvious design consideration that would be obvious to one of ordinary skill in the art. Applicant's specification fails to provide any criticality or unexpected result associated with the claimed aspect ratio, and the examiner maintains that arriving at

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any desired ratio would be well within the purview of the skilled artisan. It is also noted that the Underwood et al device may inherently be within the same aspect ratio range, but that Underwood et al simply fail to specifically disclose an aspect ratio for that portion of the device. To have provided the Underwood et al device with any desired aspect ratio to vary the treatment area size would have been an obvious design consideration for one of ordinary skill in the art.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 48 USPQ2d 1228 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1048, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 781 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 5-9, 11, 12 and 14-18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,960,207. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application claims are broader in scope and recite the same general limitations in a slightly altered order.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Peffley/
Primary Examiner
Art Unit 3739

mp
May 29, 2007

Notice of References Cited	Application/Control No. 10/808,257		Applicant(s)/Patent Under Reexamination VANNEY ET AL.	
	Examiner Michael Pettrey		Art Unit 3739	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-6,620,155	06-2003	Underwood et al.	606/32
*	B	US-6,080,151	06-2000	Swartz et al.	603/45
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.06(a).)
 Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

U.S. Patent and Trademark Office
 PTO-892 (Rev. 01-2001)

Notice of References Cited

Part of Paper No. 20070520